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REMARKS

Claims 1-19 are now pending in the present application. Reconsideration is respectfully requested in light of the amendments to the claims as well as the remarks below.

REJECTIONS UNDER 35 U.S.C. §112:

Claims 5, 10, 16 and 18 were rejected under 35 U.S.C. §112. Each of these claims has been amended to more clearly the subject matter as included therein.

OBJECTIONS UNDER 35 U.S.C. §103:

Claims 1-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bayles, U.S. Patent No. 4,287,837 in view of Long, U.S. Patent No. 3,000,681 in further view of Diamond et al., U.S. Patent No. 3,698,329. Claim 1 defines a privacy screen for use within a desk assembly having a worksurface and an open span located above the worksurface that comprises, among other things, a first member and a second member each having a generally planar first portion, a flange extending longitudinally along the first planar portion, and an end adapted to be secured to a desk assembly within the open span, wherein the flange of the second member telescopingly receives the flange of the first member, and wherein the first member and the second member are telescopingly adjustable with respect to one another, thereby allowing adjustment of an overall length of the privacy screen extending between first and second ends thereof. The Bayles, Long and Diamond et al. references as cited fail to teach, motivate, or suggest that which is defined in claim 1.

It is well established law that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d. 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Further, the mere fact that prior art may be modified in the manner suggested by the Examiner does not

make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992) (citing *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)). Moreover, the proper test for evaluating prior art under 35 U.S.C. §103 is whether or not the prior art, either individually or taken together, can be seen as suggesting the Applicant's solution to the problem which the invention addresses. *Rosemont, Inc. v. Beckman Industries, Inc.*, 732 F.2d. 1540, 1546, 221, U.S.P.Q. 1, 7 (Fed. Cir. 1984). In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references or the combination in the manner claimed. *In re Rouffet*, 42 U.S.P.Q.2d 1453,1458 (Fed. Cir. 1998). Finally, to imbue one of ordinary skill in the art with the knowledge of the invention, where no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (citing *W.L. Gore and Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-313 (Fed. Cir. 1983)).

The Examiner states that Bayles does not teach a telescopingly adjusting second portion of the privacy screen, and then cites Bayles as teaching a telescoping privacy screen (22 and 22a). However, Bayles discloses "two laterally slidable telescoping parts 22 and 22a that are essentially the same shape and comprise respectively vertical rear walls 23 and 23a, vertical side walls 24 and 24a..., and forwardly upwardly inclined walls 25 and 25a." See Long, column 1, lines 49-54. The purpose of this configuration is clearly described in column 1, lines 7-23 of the Bayles reference and, in short, includes providing an expandable waste basket. No where does Bayles teach, motivate or suggest that the purpose behind that which is disclosed is to provide privacy. Moreover, selecting only certain portions of the waste basket as disclosed by Long requires an impermissible picking-and-choosing of certain elements thereof, including selecting certain portions of integrally formed

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components. In essence, it appears that the combination of Bayles and Long is based on the argument that it would have been obvious to combine a trash can with a privacy screen regardless of the specific of the trash can. Further, the Examiner states that "Bayles, as modified [by Long] does not teach details of the telescoping adjusting second portion of the privacy screen and cites Diamond et al. as providing that which is lacking. However, Diamond et al. teaches a horizontally-positioned wall mounted shelf assembly for use within a closet. The Applicant contends that no person of ordinary skill in the art would have sought to combine the teachings of a shelf system for use within a permanent closet structure with a knock-down desk as disclosed by Bayles and/or a waste receptacle as disclosed by Long. Further, Applicant can find no teaching, motivation or suggestion within any of the art as cited by the Examiner for the idea of utilizing a closet shelf for a privacy barrier. Moreover, it appears that the overall rejection is based on the argument that it would have been obvious to one of ordinary skill in the art to modify the solid state modesty panel of Bayles by combining it with the telescoping trash can of Long, including the picking-and-choosing of certain components therefrom, and in turn combining that combination with the closet shelf of Diamond et al. The only motivation the Applicant can find for providing an adjustable length privacy panel within a desk and including the flanges as defined is located within the Applicant's own application. As noted above, such hindsight construction is improper. Therefore, claim 1 cannot be rendered obvious by that which is disclosed in Bayles in combination with Long, in further combination with Diamond et al.

Accordingly, claim 1 is in condition for allowance. Claim 12 includes similar elements to those discussed above with respect to claim 1, and is therefore also in condition for allowance for the same reason as set forth above with respect to claim 1. Claims 2-11 and 13-19 are dependent from claims 1 or 12, respectively, which are in condition for allowance, and are therefore also in condition for allowance.

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Accordingly, Applicant now believes the application to be in condition for allowance, and a Notice of Allowability is earnestly solicited.

Respectfully submitted,

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